

REMARKS

Initially, Applicants would like to thank the Examiner for the courtesy extended in discussing the most recent Office Action during a telephonic interview on September 30, 2008. An Examiner Interview Summary is presented below summarizing the discussion that took place.

This response is further being filed to respond to the Office Action mailed on July 11, 2008. Filed concurrently herewith is a *Request for a One Month Extension of Time* which extends the shortened statutory period for response to expire on November 11, 2008. Accordingly, Applicants respectfully submit that this response is being timed filed.

Claims 1-38 are currently pending in the present application with claims 1-26 being withdrawn from consideration in response to a previously issued restriction requirement. Applicants respectfully submit that claims 27-38 are in proper condition for allowance based on the reasons set forth below.

In the pages that follow below, applicants will set forth in detail that the cited prior art fails to teach or suggest:

- 1) generating a compacted motion picture roll of media segments (i.e., a compacted roll of film segments) that dramatically reduces the volume of storage required by motion picture film elements,
- 2) while retaining access to the original physical motion picture film elements on the compacted roll, and
- 3) while providing an improved ability to locate and access the original physical motion picture film elements on the compacted roll.

Examiner Interview Summary

On September 30, 2008, Applicants' undersigned representative conducted a telephonic interview with Examiner John W. Lee to discuss the Office Action mailed on July 11, 2008. During the telephonic interview with the Examiner, it was discussed that the continued rejection of

claim 37 under § 112 was improper in view of Applicants' prior amendments and in view of the Examiner's agreement that the § 112 rejection was overcome in paragraph 2 of the Office Action. The Examiner agreed to withdraw such rejection.

Applicants further stressed during the telephone interview that claims 27-37 were in fact directed to patent eligible subject matter under 35 U.S.C. § 101 in view of the fact that these claims were directed to a statutory class of "manufacture" under § 101 and were not simply a "collection of paper" as recited in paragraph 2 of the Office Action. The Examiner indicated that claim 38 was directed to patent eligible subject matter because it was directed to a "real world physical product," but the Examiner appeared to indicate that claim 27 did not require the same. Applicants' representative reminded the Examiner that claim 27 recites "a wound roll of a plurality of spliced together motion picture media segments" and further recites "a database" having a record for each segment containing locations of each segment within said roll. Applicants pointed to the Examiner's attention that the USPTO has previously found other types of "motion picture archives" to be directed to statutory subject matter and pointed his attention in particular to U.S. Patent No. 7,298,451 (e.g., claims 17+). Applicants further arguments and remarks on this point are set forth in greater detail below.

Applicants also stressed during the telephone interview that the cited *Reber* reference does not disclose a wound roll spliced together motion picture media segments having a reduced physical volume, as described in the claims. Applicants further arguments and remarks on this point are set forth in greater detail below.

Summary of Motion Picture Archive Described in Claims

The pending claims to a system or device comprising a physical wound roll of motion picture media elements occupying a reduced physical volume on a film roll. By way of background, during the filming of a motion picture, the volume of film captured (and the corresponding space occupied by such film) is typically not a concern -- rather, during a movie's production, time and money are the scarce commodities. Thus, a film will typically have originated as many as 250 reels of raw film or more, where, after the editing process is complete,

the many pieces of raw film are typically stored in 300-700 cans or boxes of film. The motion picture industry currently stores the voluminous number of boxes of film long-term, thereby occupying a great deal of space. Further, these boxes of films are typically stored in a warehouse with little to no indication of what contents are actually inside of the boxes, thereby requiring large amounts of time to search their contents to identify specific movie assets.

The invention embodied in the present claims solves many of these problems encountered by the motion picture industry when providing a new and useful system to store and locate motion picture media segments by winding the media segments onto a wound roll of spliced-together media segments, where the location of each segment in the wound roll is stored in a database allowing each segment to be easily located and retrieved later. The physical volume of space required to store the media segments is thereby reduced while maintaining accessibility to the actual media segments.

§ 101 Rejections

Applicants note that claims 27-37 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. It is asserted in the Office Action that such claims are drawn to functional descriptive material that is not claimed as residing on a computer readable medium. Applicants respectfully traverse this assertion, and reconsideration is requested based on the following remarks.

Claims 27-37 are not merely directed to “paper on which the program is written” or “a program simply contemplated and memorized by a person” as recited in paragraph 3 of the Office Action. Rather, claims 27-37 are directed to a new and useful machine or manufacture in accordance with statutory eligible subject matter defined in 35 U.S.C. § 101. As set forth in the above summary, claims 27-37 are directed to a motion picture archive comprising “a roll formed by winding the plurality of media segments, each segment spliced to another of the segments.” Thus, claims 27-37 clearly recite specific structure that is part of a statutory class of “machine or manufacture” under § 101 in that it requires: 1) a roll, 2) formed by winding the plurality of media segments, where 3) each segment is spliced to another of the segments. Claim 27 goes on to recite that the “physical volume required to store the media segments is reduced” by the wound roll that

is formed and further that “the accessibility of the plurality of media segments is maintained.” As such, claims 27-37 require a physical real world manufacture (i.e., statutory class under § 101) that includes a physical wound roll of motion picture media segments. Only actual physical products can be “wound” on a roll and “spliced together,” and “physical volume” can only be reduced on a physical real world manufacture. The Examiner’s attention is directed to FIGURE 2 of the present application that clearly illustrates the physical real world application of the roll of motion picture media segments that are spliced together. Clearly, Claims 27-37 are not merely directed to “paper on which the program is written” or “a program simply contemplated and memorized by a person” as recited in paragraph 3 of the Office Action.

With respect to use of the term “archive” in the preamble, Applicants note that the USPTO has previously found other types of “motion picture archives” to be directed to statutory subject matter and has recently allowed patents to issue on this subject matter. The Examiner’s attention is directed in particular to U.S. Patent No. 7,298,451 (e.g., claims 17+) in which the USPTO has issued claims directed to “motion picture archives.” For the foregoing reasons such, claims 27-37 are directed to patent eligible subject matter as a manufacture in accordance with 35 U.S.C. § 101, and withdrawal of the § 101 rejection is respectfully requested.

§ 112 Rejections

Applicants note that claim 37 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite because it is asserted in the Office Action that the phrase “such that” can be equivalent to the indefinite phrase “such as.” The Office Action cites MPEP §2173.05(d). Applicants respectfully traverse this assertion. The Examiner recognized during the telephonic interview that this rejection should have been withdrawn in view the amendment presented in Applicants’ last response, and paragraph 2 of the Office Action also recognizes that the § 112 rejection has been overcome and withdrawn. Withdrawal of this § 112 rejection is thus hereby requested.

§ 102 & 103 Rejections Based Primarily on *Reber*

The Office Action rejected claims 27-34 and 36-37 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. US 6,636,869 issued to Reber et al. (hereinafter *Reber*). Claim 35

was rejected under 35 U.S.C. § 103(a) as being obvious over *Reber* in view of U.S. Patent Publication No. US 2001/0014891 to *Hoffert et al.* Claim 38 was rejected under 35 U.S.C. § 103(a) as being obvious over *Reber*. Applicants respectfully traverses these rejections and reconsideration is requested based on the following remarks.

Reber Fails to Disclose a Roll of Spliced Together Media Assets

Independent claim 27 is directed to an archive of a plurality of media segments that are **spliced together and wound to form a roll**. Further, each media segment includes a location within the roll that is stored in a database to associate the media segment with its associated location so that it can be easily located on the roll and accessed. The roll of media segments further reduces the physical storage volume required of the media segments.

In paragraph 2 of the Office Action, the Examiner states:

“If the applicant had recited that an archive of a plurality of media segments are physically spliced together and wound to form a roll, then the applicant’s [previously submitted] arguments can be right. However, the claims does not recite that the roll was formed by winding the plurality of media segments physically.”

Applicants find the Examiner’s reasoning quite strange in that claim 27 specifically recites in its very first limitation: “a roll formed by winding the plurality of media segments, each segment spliced to another of the segments, wherein each segment has a location within said roll and a first information.” Claim 27 thus clearly recites 1) a roll, 2) formed by winding the plurality of media segments, where 3) each segment is spliced to another of the segments. Thus, Applicants’ respectfully request that the Examiner recognize the physical nature of the wound roll recited in claims 27-37. In fact, Claim 27 goes on to recite that the “physical volume required to store the media segments is reduced” by the wound roll that is formed, where only a physical wound roll can have a physical volume. Independent claim 38 further recites “a wound roll of the plurality of physical media segments, each segment being physically spliced to another of the segments.”

Rather than storing media segments on a wound roll, *Reber* is directed to created a digital archive by “linking or binding a digitized representation of the media” with a specific reference to the media. *See Summary of the Invention, col. 2, lines 45-47.* *Reber* further describes that:

“Digitized media data from the capture system is transferred and stored on a mass volume storage volume such as a hard disk drive as digitized media files and selectively retrieved under the control of a media storage and retrieval system which is the subject of the present application.” (col. 3, lines 50-55)

Even the cited portion of *Reber* that describes “clips” describes that “clips” can be either video or audio materials that are digitized into a media file. It is then the digitized media file that is referred to when the need arose to actually play the media associated with the clip. *See col. 1, lines 54-58.* *Reber* further describes the media archival process using such clips involves “capturing” each clip of source material for storage (col. 2, lines 17-20), where “capturing” is performed by the digitizing capturing system shown in Fig. 1. In this manner, *Reber* teaches reading content from a VTR (which may be clips) and digitizing or capturing it. There is no teaching or suggestion in *Reber* that such clips are different physical media segments from a motion picture. There is further no teaching or suggestion of physically splicing a plurality of media segments together and forming a roll by winding the spliced together media segments. Again, the clips of *Reber* are digitized (or captured) as they are read from the VTR, they are not separate pieces of media segments that are spliced together and wound into a roll. Thus, *Reber* fails to teach each and every claim limitation of independent claim 27 and its respective dependent claims.

Reber Fails to Disclose a Reduced Physical Volume Roll of Spliced Together Media Assets

Independent claims 27 and 38 recite that the physical volume required to store the plurality of media segments is reduced when combined and formed into the wound roll. Paragraph [0170] of the present application describes that such rolls have been found to occupy less than half (usually far less) than the traditional storage space required of such media segments when not formed in this manner.

Applicants note that there is no disclosure that *Reber* reduces the physical volume of storage space required to store the physical media assets. Digitizing clips into digitized media files as taught by *Reber* merely creates a digitized copy of the clips that may come from media sources such as VTRs. The physical volume occupied by the original hard copies of those clips on the VTRs of *Reber* remains the same. It is asserted in the Office Action that “it is inherent that if the

VTR's data is digitized and stored on a hard disk drive, then the segments will be reduced and it will maintain or increase the accessibility of the data via computer.” However, in order for it to be “inherent” that the physical volume of the segments will be reduced in *Reber* when the VTR's data is digitized and stored, it would be necessary for *Reber* to destroy or discard the original content coming from the VTR and only keep the digitized content. In such case, the original content coming from the VTR would no longer be accessible. As such, *Reber* does not disclose that the physical space of the content coming from the VTR is reduced in any manner.

Reber Fails to Disclose an Archive That Maintains Access to the Physical Media Assets

Independent claims 27 and 28 recite that the **physical volume** required to store the plurality of media segments is reduced when they are combined and formed into the wound roll. Independent claims 27 and 28 further recite that this reduction in volume is accomplished while maintaining **accessibility to the plurality of media segments**. Again, *Reber* could only reduce the physical volume required to store its clips coming from its VTR if it discarded such clips after digitizing them, in which case it would not be maintaining accessibility to such clips. Providing accessibility to the digitized data stored on the hard disk as suggested in the Office Action is quite different than maintaining accessibility to the plurality of media segments themselves. The digitized clips that are stored in *Reber* do not maintain access to the “physical media segments themselves” as recited in the claims. The motion picture industry needs to access the original film media segments for certain applications and mere digital copies of such media segments simply would not suffice for those certain applications. This is in part why the motion picture industry stores media segments themselves, and further why the present invention helps reduce their storage needs for these original media segments while providing improved access to such original media segments.

The Examiner recognizes in the Office Action that *Reber* fails to teach this feature for reducing the physical volume of motion picture media assets, and Applicants further rebut the Examiner's assertion that it is widely and well-known by one of ordinary skill in the art to reduce the storage volume of motion picture media assets in this manner. In fact, prior to the Applicants' invention, the entire motion picture industry (i.e., those skilled in the art) continued to store motion picture media assets in voluminous numbers of boxes of film in warehouses which has occupied a

great deal of space. Further, these boxes of films are typically stored in a warehouse with little to no indication of what contents are actually inside of the boxes, thereby requiring large amounts of time to search their contents to identify specific movie assets. The concept of reducing the physical volume of motion picture media assets in the manner invented by the present Applicants clearly has not been obvious to those skilled in the art of the motion picture industry, and it is only improperly through the hindsight of the Applicants' invention that it would appear obvious to the Examiner.

Clearly, *Reber* fails to teach or suggest reducing the physical volume required to store the plurality of media segments while maintaining accessibility to those same plurality of media segments, as recited in independent claims 27 and 28 and their respective dependent claims. Thus, each and every limitation of claims 27-38 are not taught by *Reber* or the other cited prior art references, and it is respectfully requested that the cited prior art neither anticipates nor renders such claims obvious. Reconsideration is requested.

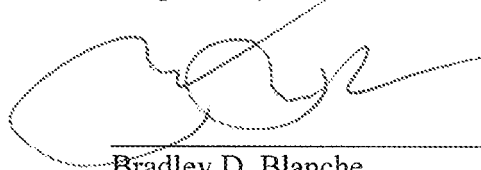
CONCLUSION

Applicant believes that this case is now in good condition for allowance, and an early Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to advance prosecution.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney Docket Number 092807-011500 is referred to when charging any payments or credits for this case.

Date: November 11, 2008

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Bradley D. Blanche', written over a horizontal dotted line.

Bradley D. Blanche
Reg. No. 38,387

Customer Number 33717
GREENBERG TRAURIG, LLP
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Phone: (310) 586-7700
Fax: (310) 586-7800
email: laipmail@gtlaw.com